

# U.S. NATIONAL STAGE WORKSHEET (A-O/EO)

3. APPL. NO. 09/830806

INTERNATIONAL APPL. GB99/03518

PUBLICATION FILED BY: 20 MOS., X OR 30 MOS., X SCREENED BY

## INTERNATIONAL APPLICATION PAPERS IN THE APPLICATION FILE:

☒ International application  
☒ Article 19 amendments  
☒ Priority Document(s) No. 2  
☒ Request Form PCT/RO/101  
☐ PCT/IB/302  
☐ PCT/IB/304  
☐ PCT/IB/306  
☐ PCT/IB/308  
☒ PCT/IB/331  
☐ OTHER PCT/IB/  
☐ PCT/IPEA/409 also 416

☒ 409 annexes to IPER  
☒ PCT/ISA/210 (Search report)  
☒ Search report References  
☐ Other Papers filed

WIPO PUBLICATION  
PUBLICATION NO. WO 01/25089  
PUBLICATION DATE 24 MAR 2001  
PUBLICATION LANG. EN  
NOT PUBLISHED  
☐ U.S. only ☐ Requested

## RECEIVED FROM THE APPLICANT: (other than checked above)

☒ National application basic fee paid  
☒ Express Processing Requested  
☒ Translation of the International Application  
☒ Used the IB copy of the IA  
☒ Description  
☒ Claims  
☒ Drawings 17  
☒ Foreign Language in drawing  
☒ Article 19 Amendments  
☒ Amendment used in application  
☒ Article 34 Amendment  
☒ Amendment used in application  
☒ NA  
☒ 94 transaction done

☒ Preliminary Amendment(s) filed 30 JUL 2001  
☐ second submission  
☒ Information Disclosure Statement  
☐ second submission  
☒ Assignment  
☒ Forward to Assignment Branch  
☒ Substitute Specification  
☒ Small Entity Statement 30 APR 2001  
☒ type  
☒ Oath/Declaration (date submitted 30 JUL 2001)  
☒ Not executed  
☒ Executed  
☐ Power of Attorney  
☐ Change of Address

3. Receipt of Request (PTO - 1399 Transmittal Letter) 30 APR 2001

Acceptable oath/declaration received 30 JUL 2001

Date 30 JUL 2001

Complete 35 USC 371 requirements met 30 JUL 2001

## DATE NOTICE COMPLETED

☐ 903 Notice of Acceptance  
☐ 905 Notice of Missing Requirements  
☐ 917 Notice of A defective oath or declaration  
☐ 916 Notice of defective response  
☐ 913 Notice of defective translation  
☐ 909 Notification of Abandonment

5/24/01  
8/13/01

# Office Action Summary

Application No.  
09/832,269

Applicant(s)  
Peyman

Examiner  
Zohreh Fay

Art Unit  
1614



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

Art Unit:

Claims 1-21 are presented for examination.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 9, 10, 11, 15, 16, 17, 18 and 21 are rejected under 35 U.S.C. 102 (b) as being anticipated by Peyman et al.. Peyman et al. Teach the use of semiconductor microphotodiode which is surgically inserted in subretinal space for the treatment of retinitis pigmentosa and restoring the vision. The above reference also teach that such implant needed external connections for power.

Claims 12, 19 and 20 are rejected under 35 U.S.C. 102 (b) as being anticipated by Majji et al.. Majji et al. Teach the use of an electrode array being surgically inserted in the epiretinal side for stimulation of vision due to photoreceptor loss.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit:

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2, 7, 8 and 13 are rejected under 35 U.S.C. 102 (e) as being anticipated by Wen et al. (U.S. Patent 6,066,675). Wen et al. Teach the use of an alpha adrenergic agonist or a beta-adrenergic agonist for the stimulation of growth factor expression and the treatment of retinal diseases. See column 3, lines 48-67. The subretinal (interphotoreceptor) application is taught by the above reference. See column 4, line 5. Slow release encapsulated is also used by the above reference. See column 4, lines 26-38.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Fay whose telephone number is (703) 308-4604.

ZOHREH FAY  
PRIMARY EXAMINER  
GROUP 1200

